

REMARKS

After entry of this paper, claims 1–22, 25, 26, and 36–49 are pending. Claims 5, 7, 14, 15, 17–22, and 36–39 are withdrawn from consideration.

Rejections Under 35 U.S.C. § 102

Claims 1, 3, 8, and 40–44 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 7,422,572 B2 (Popov). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 1 recites in part “a tissue penetrating tip”. The Examiner characterizes a lid **31** as corresponding to the recited tissue penetrating tip. Popov does not disclose the lid **31** is a tissue penetrating tip. Instead, Popov describes the lid **31** as a safety means that when closed, keeps a sharp point **3** within a safety zone **10**. Popov at 9:44–49, FIGS. **8** and **9**. The Specification and drawings of Popov do not expressly disclose the lid **31** as a tissue penetrating tip. Popov also does not inherently disclose the lid **31** as a tissue penetrating tip. The lid **31** functions to *prevent* unintended “sticks” by the sharp point **3**. Consequently, one skilled in the art would not understand the lid **31** itself as configured for penetrating tissue because such a configuration would defeat the protective function of the lid **31**. Because Popov does not disclose this feature, either expressly or inherently, claim 1 is not anticipated by Popov for at least this reason. Because claims 3, 8, and 40–43 are dependent on claim 1, these claims are also not anticipated by Popov for at least the same reason.

Independent claim 44 recites in part “a tip connected to and disposed at the distal end of the tubular body *for penetrating through a body wall* and into the body cavity”. As discussed above, Popov does not disclose a tip that penetrates a body wall. Consequently, Popov does not anticipate claim 44 for at least this reason.

Rejections under 35 U.S.C. § 103

Obviousness is a question of law based on underlying factual inquiries set forth in *Graham v. John Deere*: (1) determining the scope and content of the prior art; (2) ascertaining

the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. Objective evidence of non-obviousness must be also considered. In assessing the differences between the claim and the cited references, every feature of the claim must be disclosed or suggested in the cited references or known to one skilled in the art in making a *prima facie* case of obviousness. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003). A *prima facie* case of obviousness also requires a reasonable expectation of success in the modification or combination of references, which must be found in the cited references or must be known to one skilled in the art. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 2, 4, 6, 9–13, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Popov in view of U.S. Patent No. 5,626,598 (Roth). The Examiner relies on Roth only for disclosing that the tip of the tubular body is substantially blunt or conical, and relies on Popov for disclosing the remaining features of the rejected claims. Claims 2, 4, 12, 13, 25, and 26 are dependent on claim 1. As discussed above, Popov does not disclose the tissue penetrating tip recited in claim 1. Popov also does not suggest the recited tissue penetrating tip. Consequently, Popov and Roth together do not disclose or suggest every feature recited in claims 2, 4, 12, 13, 25, and 26, and these claims are allowable over the cited references for at least this reason.

Independent claim 6 recites in part “a tissue penetrating tip”. As discussed above, Popov does not disclose or suggest the recited tissue penetrating tip. Consequently, Popov and Roth together do not disclose or suggest every feature recited in claim 6, or in claims 9–11, which are dependent on claim 6. Accordingly, claims 6 and 9–11 are not obvious over the cited references for at least this reason.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Popov. Claim 16 is dependent on claim 1. Because Popov does not disclose or suggest every feature recited in claim 1, Popov also does not disclose or suggest every feature recited in claim 16. Consequently, claim 16 is allowable over Popov for at least this reason.

New Claims 45–49

The features recited in new claims 45–49 are not disclosed or suggested in any combination of the references of record. Consequently, these claims are allowable for at least this reason.

Rejoinder of Withdrawn Claims

Applicants request rejoinder of withdrawn claims 5, 7, 14, 15, 17–22, and 36–39 because these claims are all dependent on allowable base claims.

No Disclaimers or Disavowals

Although the present paper may include a combination of alterations to the application or claims, or characterizations of claim scope or referenced art, Applicants are not conceding that previously pending claims in this application are not patentable over the cited references. Rather, any alterations and/or characterizations are made to facilitate prosecution of this application. Applicants reserve the right to pursue any previously pending, or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or in any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Conclusion

Applicants submit that all of the Examiner's rejections have been addressed and overcome, and that all claims are allowable over the art of record. Applicants have submitted amendments and arguments believed to be sufficient to overcome all of the outstanding rejections. Consequently, Applicants have not advanced every argument for the allowability of the claims over the references of record. As such, Applicants do not acquiesce to any of the Examiner's statements or characterizations not specifically traversed. Should the Examiner believe that any outstanding issues are resolvable in an Examiner's Amendment, the Examiner is invited to contact the undersigned.

Application No. 10/805,864

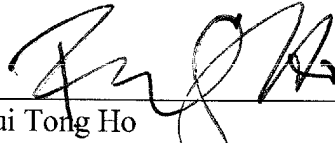
Responsive to an Office Action dated February 5, 2009

Response filed April 30, 2009

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 01-2215.

Respectfully submitted,
APPLIED MEDICAL RESOURCES

BY

A handwritten signature in black ink, appearing to read 'Pui Tong Ho', written over a horizontal line.

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